



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Prosecution Number (Optional)

42P17675

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Signature

Typed or printed
name Margaux Rodriguez

Application No.

10/700,910

Filed

November 3, 2003

First Named Inventor

Christopher J. Cormack

Art Unit

2176

Examiner

Bashore, William L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

NOTE: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under of 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ Attorney or agent of record.
Registration Number 42,261
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Farzad E. Amini

Typed or printed name

(310) 207-3800

Telephone Number

March 15, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required.

☐ *Total of _____ forms are submitted.



Pre-Appeal Brief Request for Review

Application No. 10/700,910
Attorney Docket No.: 42P17675

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Christopher Cormack, et al.

Serial No.: 10/700,910

Filed: November 3, 2003

For: ANNOTATING MEDIA CONTENT WITH
USER-SPECIFIED INFORMATION

Examiner: Bashore, William L.

Group Art Unit: 2176

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Final Office Action of September 15, 2006, please consider the following Pre-Appeal Brief Request for Review for the above-identified application.

Claims 16-20 are pending. In the Final Office Action, the Examiner rejected claims 1-5 and 16-20 under 35 U.S.C. §101; and rejected claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over Nelson, et al (U.S. Publication No. 2004/0236830 A1) in view of King, et. al. (U.S. Patent No. 5,600,775).

35. U.S.C. §101 Rejection

Independent claim 16 provides:

16. (Original) A method, comprising:
outputting stored media information based on an associated index file;
receiving an annotation request at a point in the index file;
receiving and storing annotation information associated with the annotation request; and
modifying the index file at the point at which the annotation request was received to reference the stored annotation information.

Regarding the §101 rejection, Applicants respectfully note that the response on pages 19 and 20 of the Final Office Action adds nothing of substance to the rejection and does not answer Applicants' traversal. It continues to complain that method claims 16-20 "are not limited to tangible embodiments" and "fail to set forth physical structures or materials comprising of hardware." Again, this is a "machine implemented test," which is not a proper test for subject matter eligibility. See again Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (22 November 2005), Annex III "Improper Tests For Subject Matter Eligibility," section d) "Machine Implemented Test": "A finding that a claim fails to recite a computer-implemented process is not determinative in whether that claim passes muster under Sec. 101." This continues to be clear legal error.

Processes (including their component steps or acts) are *prima facie* statutory. See the quoted portion of 35 U.S.C. §101 on page 19 of the Final Office Action: "... any new and useful process ...". The undersigned knows of no statutory or case law requirement that a process or method claim state exactly what physical structures are used to perform its component steps or acts. This is because there is no such requirement. If the Examiner knows of such a requirement, he is respectfully requested to document it. Otherwise, the Examiner should withdraw this legally erroneous position.

The proper focus for the Examiner should be whether the claimed invention has “specific and substantial” utility (see M.P.E.P. §2107.02). As noted therein, “In most cases, an applicant’s assertion of utility creates a presumption of utility that will be sufficient to satisfy the utility requirement of 35 U.S.C. 101” M.P.E.P. §2107.02(III)(A). In this context, method claims 1-5 and 16-20 plainly have well-established, specific and substantial utility in view of the disclosure of, for example, the media stream 105, media device 110, input device 170, and display device 180 in Fig. 1 of the specification (and their associated description).

If the Examiner persists in a §101 rejection, he is respectfully requested to address and factually support his various burdens under M.P.E.P. §2107.02(IV). These are listed on pages 2100-31 and 2100-32 of the M.P.E.P., 8th Ed., Rev. 5, Aug. 2006. A *prima facie* showing of lack of utility has not been made to date, and if the Examiner persists in this rejection, he should do Applicants the courtesy of following the requirements (note the repeated use of the word “must”) laid out by M.P.E.P. §2107.02(IV) so that the rejection may be properly addressed.

35 U.S.C. § 103 Rejection

Applicants note that the Office Action is insufficient to establish a *prima facie* case of obviousness. For example, contrary to page 10 of the Final Office Action, the “outputting stored media information . . .” limitation is not read on either of Nelson, et al. or King, et al. in the rejections of claims 1, 7, and 12. Given that there is only one independent claim remaining, Applicants respectfully request a specific and detailed reading of each of its limitations on the applied references to improve the record for appeal.

A *prima facie* case of obviousness has not been established for claims 16-20 at least because the references as combined fail to teach or suggest all the claim limitations. Claims 16-20 require a method including, inter alia, “outputting stored media information based on an associated index file; receiving an annotation request at a point in the index file; and modifying the index file at the point at which the annotation request was received to reference the stored annotation information.” The combination of Nelson, et al. and King, et al. fails to teach or suggest at least these limitations.

Regarding the “outputting stored media information based on an associated index file; and receiving an annotation request at a point in the index file” limitations, Nelson, et al. fails to teach or suggest these, because it only discloses annotating a real-time video conference. See,

for example, paragraph 0068. Thus, Nelson, et al. fails to teach or suggest “receiving an annotation request at a point in the index file” on whose basis “stored media information” is output, as required by claims 16-20.

Also, neither reference teaches or suggests “modifying the index file at the point at which the annotation request was received to reference the stored annotation information.” Nelson, et al. does not teach or suggest this, because it fails to teach the “index file” on whose basis “stored media information” is output. Thus, it cannot logically teach or suggest “modifying” such an index file, as required by claims 16-20.

As previously explained, and not addressed by the Final Office Action, King, et al. actually teaches away from modifying an index of media information, as claimed. King, et al. provides at col. 2, lines 17-31 (with emphasis added):

The method includes displaying the file of indexed data structures using a file display routine, and selecting in response to user input an indexed data structure to be annotated from the file of indexed data structures being displayed. **Next, an annotation data structure is created in response to user input using an annotation routine without modifying the selected data structure.** The annotation data structure includes a graphical element for display overlaying the selected data structure and an indication of an index value for the selected data structure. **The annotation data structure is stored in an annotation file apart from the file of indexed data structures.**

The cited portion of King, et al. teaches creating a separate annotation data structure “without modifying the selected [indexed] data structure.” This teaches directly away from “modifying the index file at the point at which the annotation request was received to reference the stored annotation information” as required by claims 16-20.

Thus, a *prima facie* case of obviousness has not been established for claims 16-20, and the 35 U.S.C. §103(a) rejection should be withdrawn.

Reconsideration and allowance of pending claims 16-20 are respectfully requested.

In conclusion, Applicants maintain that the Examiner has failed to maintain a *prima facie* rejection under §101 and §103(a) and thus allowance of all the claims is respectfully requested.

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Application No. 10/700,910
Attorney Docket No.: 42P17675

To the extent necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: March 15, 2007.

By


Farzad E. Amini, Reg. No. 42,261

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF MAILING

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Margaux Rodriguez

March 15, 2007